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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/390,740	02/17/1995	ROGER COLEMAN		7334

22428 7590 06/24/2005  
FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

08/390,740

Applicant(s)

COLEMAN ET AL.

Examiner

Ardin Marschel

Art Unit

1631

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 1/21/05 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 22 February 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See further explanation as attached. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 40,41,46,47,52-54 and 105-110.  
Claim(s) withdrawn from consideration: 43,44,48,49,51,55,56,58-75,80,81,84,85 and 88-104.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: of reasons as explained as attached.  
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). (1 sheet)  
13. ☐ Other: \_\_\_\_\_

*HC*

### **DETAILED ACTION**

Further explanation of item # 3 on the enclosed Advisory action:

The proposed amendment, filed 1/21/05, contains NEW MATTER regarding the 95% sequence identity sharing of variants in parts b) of claims 40, 107, and 108, and claims dependent therefrom. Consideration of the entirety of the instant disclosure as originally filed has failed to reveal any such 95% sequence identity limitation. Applicants have pointed to written support for this as filed on page 7, first full paragraph, referring to the 1 - 5 amino acid insertion or deletion description. In response, it is acknowledged that a 5 amino acid change compared to the 97 amino acids of SEQ ID NO: 2 is about 95% sequence identity but that the amendment does not state "about 95%". Also, a 95% sequence identity limitation as present in the proposed claims is inclusive of variants wherein substitutions of up to 5% are present in the amino acid sequence which is not disclosed in said page 7 disclosure which is therefore clearly still NEW MATTER compared to said page 7 disclosure. The page 7 disclosure only cites the 1 - 5 amino acid variation regarding insertions or deletions. Another issue of NEW MATTER is that the disclosure of SEQ ID NO: 2 per se directed to variants of SEQ ID NO: 2 having the above sequence variant options has not been disclosed as filed corresponding to said parts b) of instant claims 40, 107, and 108, etc.

The above NEW MATTER descriptions would raise new issues requiring further consideration and/or search as well thus supporting the non-entry of said proposed amendment.

Further explanation of item # 11 on the enclosed Advisory action:

The above non-entry of the amendment includes non-entry of the proposed title change. If the amendment had been entered, however, the proposed title would have

overcome the objection to the title set forth in the previous office action, mailed 10/20/04.

The NEW MATTER rejection of claims 40, 41, 46, 47, 52-54, and 105-110 is maintained and reiterated from the previous office action, mailed 10/20/04, however, would have been overcome if the amendment, proposed 1/21/05, had been entered.

The rejection of claims 40, 46, 47, 52, 53, and 107-110 under 35 USC 102(b) as being clearly anticipated by Yoshimura et al. [FEBS Lett. 244(2):487 (1989)] is maintained and reiterated from the previous office action, mailed 10/20/04. Even if the proposed amendment, filed 1/21/05, had been entered, this rejection would have been maintained due to proposed claim 40; parts c), g), and i); citing a polynucleotide encoding a biologically active fragment of a polypeptide which is further characterized regarding SEQ ID NO: 2 with chemotactic activity. The fragment per se of the part c) polypeptide reasonably is inclusive of a corresponding fragment in the prior art reference. The fragment per se only is required to have chemotactic activity which was described in previous office actions regarding Yoshimura et al. molecules. It is the polypeptide, and not the fragment thereof, in instant claim 40, part c), which consists of SEQ ID NO: 2. Instant claim 52 would also remain rejected over said prior art due to the part b) proposed claim wording therein directed to "consists essentially" wording which is reasonably inclusive of variants which may have more than 5 amino acid deletions or insertions as long as they still have the functional activity as claimed which has been established for variants of said reference in prior office actions. Claims 46, 47, 53, and 107-110 also would be maintained as rejected under this issue for the same reasons directed to the above claim 40 regarding corresponding limitations in these claims or claims dependent from claims 40 or 52.

No claim is allowed.

### **POSSIBLE INTERFERENCE PROCEEDING**

Regarding the possible interference proceedings with Luster et al. (P/N 6,403,782) noted in the previous office action, mailed 11/25/03; this issue is held in abeyance at this time due to awaiting compliance with 37 CFR 41.102 regarding completion of examination. An interference proceeding regarding an application is deemed to define a contested case subject to 37 CFR 41.102 as defined in 37 CFR 41.200, part (a).

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the Central PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The Central PTO Fax Center number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., Supervisory Patent Examiner, whose telephone number is (571) 272-0718. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 22, 2005

*Ardin H. Marschel 6/22/05*  
**ARDIN H. MARSCHEL**  
**SUPERVISORY PATENT EXAMINER**